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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,230	03/11/2004	Melvin L. Hubbard	00118/005001	3466
7590 10/20/2005			EXAMINER	
Mark D. Wieczorek, Ph.D., Esq. C/o Mayer Fortkort & Williams 251 North Avenue West Westfield, NJ 07090			TRUONG, THANH K	
			ART UNIT	PAPER NUMBER
			3721	

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/798,230

Applicant(s)

HUBBARD, MELVIN L.

Examiner

Thanh K. Truong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2,5-8,10-14 and 31-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2,5-8,10-14 and 31-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9-20-05

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Species 3, the embodiment of figure 8, claims 2, 5-8, 10-14 and 31-33, in the reply filed on July 26, 2005 is acknowledged.
2. Applicant's cancellation of claims 1, 3, 4, 9 and 15-30 is acknowledged.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 2, 31 and 32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent No. 6,609,576. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1 and 2 of U.S. Patent No. 6,609,576 anticipate claims 2, 31 and 32 of the present application.

5. Claims 2, 31, 32 and 33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 10, 11 and 13

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of U.S. Patent No. 6,715,563. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 10, 11 and 13 of U.S. Patent No. 6,715,563 anticipate claims 2, 31, 32 and 33 of the present application.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 31 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 31 recites "substantially or entirely constricting the axle against rotation, wherein the housing is caused to rotate" deems to be a new matter, because there is no support in the original disclosure for the "constricting" of the axle or the rotation of the housing.

The Applicant is also being reminded that the embodiment of figure 8 is the elected species for the examining of this application.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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9. Claims 2, 5-8, 10-14, 31 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 33 recites the limitation "said second axle" in line 10. There is insufficient antecedent basis for this limitation in the claim.

The recitation "substantially or entirely constricting" in claim 31, line 13 is vague and indefinite, because it is unclear which is being claimed – substantially constricting or entirely constricting?

The recitation "substantially or entirely constricting the axle against rotation, wherein the housing is caused to rotate" in claim 31, lines 13-14, is vague and indefinite, because it is unclear what the Applicant is referring to? Furthermore, there is no support for the claimed limitation "constricting" in the original disclosure.

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 2, 6-8, 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Golobay (4,087,982) in view of Vural et al. (4,265,130).

Golobay discloses an apparatus and a method comprising:

providing a housing containing at least one off-center weight (42), the off-center weight coupled to a motor (52) and configured to rotate or revolve to vibrate the housing,

removably mounting the housing via a device mount to a mount on a vehicle (22) (figure 1);

providing a belt (54) to the first axle (44);

providing a belt coupled to the first axle;

removably mounting a tool to a second axle (70), to perform a task; and

rotating or revolving the off-center weight (figure 2).

Golobay discloses the claimed invention, but does not expressly disclose the ratchet rotatably coupled to the housing, such that vibration of the housing causes rotation of the first axle.

Vural et al. discloses a ratchet (7) having a first axle (1) about which the ratchet may rotate, the ratchet rotatably coupled to the housing (the ratchet (7) rotated around the axle (1) which coupled to the housing, thus the ratchet is rotatably coupled to the housing), such that vibration of the housing causes rotation of the first axle providing means to adjust the relative angular position and locking the adjustable weight in each setting by means of a set amount of friction (column 5, lines 5-10).

Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Golobay et al. by incorporating the use of a ratchet as taught by Vural et al. providing means to lock and to adjust the relative angular position of the off-center weight.

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Golobay further discloses: the tool is the cable layers; the cutting tool is a trencher; a cable-layering system, whereby cable may be laid while a trench is dug; and a soil separating system, whereby soil may be separated while a trench is dug.

12. Claims 5 and 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Golobay (4,087,982) in view of Vural et al. (4,265,130).

As discussed above in paragraph 11 of this office action, the combination of Golobay and Vural et al. disclose the claimed invention, but did not expressly disclose the tool is an asphalt cutter (claim 5), the tool is a drill (claim 10), etc.

The examiner take an Official Notice that it is old and well known in the art to attach varieties of tools (such as asphalt cutter, drill, etc. as recited in claims 5 and 10-14) to the housing of a vibration generator as one desires to achieve varieties of purposes.

Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have attached varieties of tools to the housing of a vibration generator depending on the task required.

#### ***Allowable Subject Matter***

13. Although claim 31 is not rejected by prior art, but because of its indefiniteness, the allowable subject matter of claim 31 cannot be determined at this time. However, if the indefiniteness of the claim is resolved, claim 31 will be treated on the merit.

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**Conclusion**

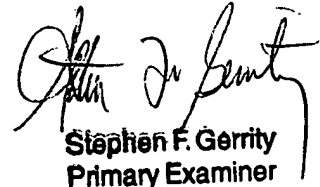
14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh K. Truong whose telephone number is 571-272-4472. The examiner can normally be reached on Mon-Thru 8:00AM - 6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tkk  
October 12, 2005.

  
Stephen F. Gerrity  
Primary Examiner